UNITED STATES PATENT AND TRADEMARK OFFICE

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10/709,182	04/20/2004	Thomas David Snyder	PU03 0233US1.76	3181

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EXAMINER
SIDDIQUI, KASHIF

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on *11 January 2010*.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1,4-16 and 19-37* is/are pending in the application.
     4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1,4-16 and 19-37* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on *20 April 2004* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
     a) ☐ All   b) ☐ Some * c) ☐ None of:
       1. ☐ Certified copies of the priority documents have been received.
       2. ☐ Certified copies of the priority documents have been received in Application No. _____.
       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This Office Action is in response to the Applicants' communication filed on

1/11/2010. In virtue of this communication, claims 1, 4-16, and 19-37 are currently

presented in the instant application.

Information Disclosure Statement

2.   The information disclosure statement (IDS) Form PTO-1449, filed on 1/20/2010

is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information

disclosure statement is being considered by the examiner.

Continued Examination Under 37 CFR 1.114

3.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

1/11/2010 has been entered.

Response to Arguments

4.   Applicant's arguments with respect to claims 1, 4-16, and 19-37 have been

considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim(s) is/are NOT directed to a process, machine, manufacture or composition of matter. The claimed "computer readable storage medium" are defined in Applicant's specification (par. 0018) where a computer readable storage medium may be "a propagation medium." Therefore, a reasonable interpretation in light of the specification leads to the conclusion that the claim encompasses transitory signals, which does not fall within the definition of a process, machine, manufacture or composition of matter. Examiner suggests amending the claims to recite "A non-transitory computer program product" or "a non-transitory computer usable medium/program code" where appropriate. See Official Gazette Notice 1351 OG 212 (February 23, 2010).

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7.   Claims 12-15 and 27-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 recites the limitation "the SMS text

message" in line 2 of the claim. There is insufficient antecedent basis for this limitation

in the claim. For the purposes of examination, Examiner will interpret "the SMS text

message" as "an SMS text message."

8.   Further, a broad range or limitation together with a narrow range or limitation that

falls within the broad range or limitation (in the same claim) is considered indefinite,

since the resulting claim does not clearly set forth the metes and bounds of the patent

protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board

of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat.

App. & Inter. 1989), as to where broad language is followed by "such as" and then

narrow language. The Board stated that this can render a claim indefinite by raising a

question or doubt as to whether the feature introduced by such language is (a) merely

exemplary of the remainder of the claim, and therefore not required, or (b) a required

feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131

USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte*

Hasche, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 12, based upon

its dependency to claim 11, recites the broad recitation "a plurality of methods of

delivery", and the claim also recites, in the language of claim 12, "opening the SMS text

message" which is the narrower statement of the range/limitation. The claim language

implies that a user is presented with a plurality of delivery choices to select from, but the

delivery method is always via SMS text message.

9.   A similar reasoning applies to the other claims under this heading.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

11.   Claims 1, 4, 8, 9, 11-13, 16, 19, 23, 24, 26, 27, and 28 are rejected under 35

U.S.C. 103(a) as being unpatentable over publication number US 2005/0054333 A1

to Johnson (herein Johnson).

With regard to claim 1, the limitation "A method of storing a phone number

within a mobile phone, said phone number received from an information service, the

method comprising: placing a call to an information service to obtain a requested phone

number" is met (by Johnson, Abstract, where a user can dial directory assistance,

request a number, and have the number stored into the mobile phone telephone

directory).

Johnson does not explicitly teach the limitation "prompting a user of the mobile

phone for a method of delivery of the requested phone number by presenting a plurality

of methods of delivery, wherein each method of delivery comprises a different channel

for transmitting the requested phone number to the mobile number." However, Johnson

teaches (par. 0020, that the user is prompted regarding whether or not the user wishes

to download the telephone number to his wireless device. The telephone number is

sent as a data message which can be via SMS, HTTP transfer, or an update to the

user's website which is synched to the handset. All of these methods are different and utilize different channels for transmission (e.g. SMSC for SMS or GPRS/3G etc. for HTTP). Johnson does not indicate that the user is presented the different methods. However, there are only a finite number or possibilities for the method of delivery to be selected. Either the user is asked which method to use or the user instructs the service of which method to use before being asked. Given the small number of possibilities it would have been obvious to one of ordinary skill in the art to try either option; and it would have been a design choice to choose one of the two aforementioned possibilities. Further, the apparent intent of Johnson is to provide ease to a user when trying to remember a number (Johnson par. 0005). In the further interest of providing ease, a prompt asking to choose a delivery method would be easier for the user rather than instructing the service before being asked because in order to instruct before being asked, the user would have to be familiar with the directory service, would have to be familiar with his handset when providing the instructing, and would further have to be familiar with the data plans available to him on his wireless service contract.

The limitation "transmitting a selection of selecting a selected method of delivery for the requested number by the user" is met by Johnson and similar reasons given in the above limitation.

The limitation "receiving the requested phone number at the mobile phone from the information service in response to the information service receiving a user selection of the method of delivery" is met (by Johnson, par. 0020, where upon choosing to download the number, the server sends the number to the wireless device).

The limitation "detecting the requested phone number returned from the information service in accordance with the selection made by the user" is met (by Johnson, par. 0020-0021, where the directory information is received [by the method selected, as explained above]).

The limitation "storing the requested phone number returned from the information service within the mobile phone" is met (by Johnson, par. 0020-0021, where after receiving the directory information, the wireless device utilizes an application to create an entry in the wireless device and store the directory information).

With regard to claim 4, the limitation "wherein storing the requested phone number returned from the information service within the mobile phone comprises having the mobile phone prompt the user whether to store the returned phone number" is met (by Johnson, par. 0020, where after the number is retrieved by the directory service, the user is asked if he would like to download the number. Downloading requires storing and the number will not be stored if the download is not authorized).

With regard to claim 8, the limitation "prompting the user whether to automatically dial the returned phone number" is met (by Johnson, par. 0020, where the directory service prompts the user as to whether the user wants to be automatically connected to the destination party).

With regard to claim 9, the limitation "wherein storing the requested phone number returned from the information service within the mobile phone comprises having the mobile phone automatically store the returned phone number within the mobile phone's phonebook directory" is met (by Johnson, par. 0020-0021, where upon permitting the download, the directory entry is automatically stored as an entry in the telephone book of the wireless device).

Claim(s) 11, 16, and 26 is/are rejected for the same reasons as set forth in claim 1 above, because they have similar limitations.

Claim(s) 13, 19, and 28 is/are rejected for the same reasons as set forth in claim 4 above, because they have similar limitations.

Claim(s) 12, 23, and 27 is/are rejected for the same reasons as set forth in claim 8 above, because they have similar limitations.

Claim(s) 24 is/are rejected for the same reasons as set forth in claim 9 above, because they have similar limitations.

12.   Claims 5, 6, 14, 15, 20, 21, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson as applied to claim 1 above, and further in view of patent number 5764731 to Yablon (herein Yablon).

With regard to claim 5, Johnson does not explicitly teach the limitation "wherein storing the requested phone number returned from the information service within the mobile phone further comprises having the mobile phone prompt the user where to store the returned phone number." Johnson teaches automatically downloading the phone number to the memory of the wireless device. However, attention is directed to Yablon (which teaches, col. 13, ll. 20-35, where as an alternative to storing the number into the next available (empty) memory location, the primary user could tell the number source or the telephone which memory location the particular number should be entered into).

Therefore it would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the Johnson invention by employing the teaching as taught by Yablon to provide the ability for the user to choose where to store the returned telephone number. Yablon is also directed to the same subject matter as Johnson which is to allow a user to contact a directory assistance service to obtain a telephone number which can be stored to the user's telephone memory (Yablon, Abstract). Yablon does not specify that the primary user receives a prompt to select the memory location; however, as stated above in claim 1, it would be obvious to one of ordinary skill in the art to utilize prompts as this would increase the amount of ease given to the user's experience when contacting a directory service.

With regard to claim 6, the limitation "wherein the returned phone number is stored within the mobile phone's phonebook directory" is met (by Johnson, par. 0020-0021, where upon permitting the download, the directory entry is stored as an entry in the telephone book of the wireless device).

Claim(s) 14, 20, and 29 is/are rejected for the same reasons as set forth in claim 5 above, because they have similar limitations.

Claim(s) 15, 21, and 30 is/are rejected for the same reasons as set forth in claim 6 above, because they have similar limitations.

13.   **Claims 7, 22, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson and Yablon as applied to claims 1 and 5 above, and further in view of patent number US 6185295 B1 to Frederiksen et al. (herein Frederiksen).**

With regard to claim 7, Johnson and Yablon do not explicitly teach the limitation "wherein the returned phone number is stored on a SIM card attachable to the mobile phone." Johnson teaches (par. 0020-0021, that upon permitting the download, the directory entry is stored as an entry in the telephone book of the wireless device). Yablon teaches allowing a user to select where to store the telephone number. However, attention is directed to Frederiksen (which discloses, col. 1, ll. 10-15, that a

user has the possibility of storing a plurality of phone numbers electronically and that the storage can take place in the RAM of the phone or in a SIM card).

Therefore it would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the Johnson invention by employing the teaching as disclosed by Frederiksen to provide the ability for the phone numbers to be directory stored to the SIM card rather than the RAM of the phone. The motivation for the combination is given (by Frederiksen, col. 1, ll. 10-15, where storing the numbers to the SIM card allows the phone number database to follow the subscription instead of the phone (e.g. user upgrades phone on existing service contract)).

Claim(s) 22 and 31 is/are rejected for the same reasons as set forth in claim 7 above, because they have similar limitations.

14.   Claims 10 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson as applied to claim 1 above, and further in view of Frederiksen.

With regard to claim 10, Johnson does not explicitly teach the limitation "wherein storing the requested phone number returned from the information service within the mobile phone comprises having the mobile phone automatically store the returned phone number on a SIM card attachable to the mobile phone." Johnson teaches (par. 0020-0021, that upon permitting the download, the directory entry is automatically stored as an entry in the telephone book of the wireless device).

However, attention is directed to Frederiksen (which discloses, col. 1, ll. 10-15, that a user has the possibility of storing a plurality of phone numbers electronically and that the storage can take place in the RAM of the phone or in a SIM card).

Therefore it would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the Johnson invention by employing the teaching as taught by Frederiksen to provide the ability for the phone numbers to be directory stored to the SIM card rather than the RAM of the phone. The motivation for the combination is given (by Frederiksen, col. 1, ll. 10-15, where storing the numbers to the SIM card allows the phone number database to follow the subscription instead of the phone (e.g. user upgrades phone on existing service contract)).

Claim(s) 25 is/are rejected for the same reasons as set forth in claim 10 above, because they have similar limitations.

15.   **Claims 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of publication number US 2004/0120493 A1 to Creamer et al. (herein Creamer).**

With regard to claim 32, the limitation "A method of storing a phone number within a mobile phone, said phone number received from an information service, the method comprising: placing a call to an information service to obtain a requested phone number" is met (by Johnson, Abstract, where a user can dial directory assistance,

request a number, and have the number stored into the mobile phone telephone

directory).

The limitation "having the information service automatically connect the mobile

phone to the requested phone number" is met (by Johnson, par. 0020, where the

directory service prompts the user as to whether the user wants to be automatically

connected to the destination party).

Johnson does not explicitly teach the limitation "detecting the requested phone

number that the information service connected the mobile phone to based on a

connection established between the mobile phone and the requested phone number in

response to the mobile phone being connected to the requested phone number."

However, attention is directed to Creamer (which teaches, par. 0026, that digital signals

within the ringback can convey connectivity information to the originating device (i.e.

caller) which can be the called person ID (the reverse of caller ID) (i.e. a telephone

number). The ringback would occur when the originating device is connected to the

number of the destination).

Therefore it would have been obvious to one of ordinary skill in the art at the time

that the invention was made to modify the Johnson invention by employing the teaching

as taught by Creamer to provide the telephone number to the user via a ringback.

Upon receiving the number, the invention of Johnson would be able to function as

described. The motivation for the combination is given (by Creamer, par. 0026, where

the called person ID can be useful in situations where a user of an originating device

has been transferred to an unknown phone number).

The limitation "storing the detected requested phone number that the information service connected the mobile phone to" is met (by Johnson, par. 0020-0021, where after receiving the directory information, the wireless device utilizes an application to create an entry in the wireless device and store the directory information).

With regard to claim 33, the limitation "wherein detecting the requested phone number that the information service connected the mobile phone to comprises obtaining the information via a network query and response" is met (by Creamer, par. 0004 and 0026, where the ringback is generated by the telephony switch and is provided to the originating device. The initiation of the call is the query, the ringback is the response).

Claim(s) 34 is/are rejected for the same reasons as set forth in claim 4 above, because they have similar limitations.

16.   **Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Creamer and further in view of Yablon.**

Claim(s) 35 is/are rejected for the same reasons as set forth in claim 5 above, because they have similar limitations.

Claim(s) 36 is/are rejected for the same reasons as set forth in claim 6 above, because they have similar limitations.

17.   Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Creamer and further in view of Yablon and further in view of Frederiksen.

Claim(s) 37 is/are rejected for the same reasons as set forth in claim 7 above, because they have similar limitations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KASHIF SIDDIQUI whose telephone number is (571)270-3188. The examiner can normally be reached on Monday through Thursday 7:30-18:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kent Chang can be reached on (571)272-7667. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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